



PATENT *EL978317705US*
09/843,059
#11
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	: Before the Examiner:
Rabindranath Dutta, et al.	: Chongshan Chen
Serial No.: 09/843,059	: Group Art Unit: 2172
Confirmation Number: 8459	: Intellectual Property Law Department
Filed: 4/26/2001	: International Business Machines Corp.
Title: Browser rewind and replay feature for	: 11400 Burnet Road
transient messages wherein the messages are stored	: Austin, Texas 78758
automatically when they are initially rendered and	
replayed when selected	

CERTIFICATE OF MAILING

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APPELLANT'S BRIEF UNDER 37 CFR 1.192

This is an appeal of a final rejection dated December 17, 2003 of Claims 1-4, 7-10, 13-16 and 19-24 of application serial number 09/843,059, filed 4/26/2001. This brief is submitted pursuant to a Notice of Appeal filed, March 16, 2004 as required by 37 CFR 1.192.

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I. Real party in Interest

The real party in interest is International Business Machines Corporation, the assignee.

II. Related Appeals and Interferences

The Appeal of a patent application having serial number 09/843,063 and filed April 26, 2001 is known to Appellant. This other Appeal may directly affect or be directly affected by or have a bearing on the Board's decision in this pending Appeal.

III. Status of Claims

Claims 1-4, 7-10, 13-16, and 19-24 are currently pending and are being appealed.

Claims 5, 6, 11, 12, 17, 18 have been cancelled.

The pending rejected claims that form the basis of this appeal are reproduced in the attached Appendix.

IV. Status of Amendments

No amendments have been filed subsequent to the final rejection.

V. Summary of the Invention

The present invention encompasses a method, system, and program that enables transient messages that are received over a network to be displayed at a client (page 8,

lines 13-18; and page 15, line 26 to page 16, line 2). A multimedia object may contain one or more of the transient messages (page 8, lines 21-22). The multimedia objects are stored in a chronological list when each multimedia object is initially rendered at the client (page 8, lines 26-29). The chronological list is displayed with control buttons (page 17, lines 7-10; and Fig. 3, numerals 361-366). In response to a user selection of one of the displayed control buttons, the stored multimedia objects will be subsequently rendered in either a forward or backward succession (page 9, lines 2-15; and page 17, lines 7 to page 18, line 6). The rate at which the sequence of stored multimedia objects are subsequently rendered is user configurable (page 18, lines 1-6). The displayed control buttons are independent of any playback control displayed in conjunction with initially rendering any of the multimedia objects (page 16, line 25 to page 17, line 15).

The invention may further comprise the following described features. The multimedia objects may be an animated GIF, a moving picture type multimedia object, a vector graphic multimedia object, or a static image multimedia object (page 13 line 21 – page 14, line 10). The duration of time for which the storing of the rendered multimedia objects occurs is user configurable (page 16, lines 8-13). The multimedia objects may be stored in the chronological list at either the client or at a server (page 16, lines 15-16; and page 19, lines 5-10). They are stored as each object is initially rendered at the client (page 16, lines 6 – 20; and page 8, lines 26-29). Consequently, a given multimedia object with its corresponding software unit is sent to the client to enable the object to be played in response to a selection of a replay button that is sent from the server and displayed in

conjunction with the multimedia object in an area of a document allocated to the multimedia object (page 19, lines 18-30).

Yet another feature of the invention for redisplaying, at a client, transient messages displayed in a browser enables regions associated with the transient messages to be identified and then clipped (page 22, lines 23 – 27). As above, the transient messages are then stored in a chronological list and the list is displayed with control buttons for enabling a subsequent rendering of the transient messages in a forward or backward succession at a user configurable rate in response to a user selection of the displayed control buttons. Furthermore, a separate identifier is associated with each stored transient message and the identifier is used for the user selection (page 22, lines 23 – 27).

Due to the dynamic and random nature of advertisements such as browser based banner advertisements, a user may miss an advertisement that the user may otherwise have been interested in. The present invention automatically stores these advertisements without requiring the user to select an advertisement; and enables the user to go forward or backward through the chronological list of stored advertisements.

VI. Issues Presented for Review

Whether the examiner failed to provide a *prima facie* case of obviousness under 35 USC 103(a) for claims 1-4, 7-10, 13-16, and 19-24 with the combination of Moore et al. (“Moore” Pub No US 2001/0039546) and White (“White” Pub No US 2002/0056098) and Hullinger et al. (“Hullinger” 6,295,092), and Ahmad et al. (“Ahmad” 6,005,564).

VII. Grouping of Claims

The rejected claims do not stand or fall together.

Claims 1-4, 8, 9, 10, 13, 14, 15, 16, 19, 20, and 21-24 all stand or fall together as referred to herein as the group I claims.

Claim 7, referred to herein as the group II claim, stands with the group I claims if the group I claims stand, but may also stand separately even if the group I claims fall.

VIII. Argument

The examiner has finally rejected claims 1-4, 7-10, 13-16, and 19-24 under 35 USC 103(a) as being unpatentable over Moore et al. ("Moore" Pub No US 2001/0039546) in view of White ("White" Pub No US 2002/0056098) in view of Hullinger et al. ("Hullinger" 6,295,092), and further in view of Ahmad et al. ("Ahmad" 6,005,564).

A *prima facie* case of obviousness has not been established with this combination of references.

Applicants' disclosure cannot be used as a blueprint to reconstruct the claimed invention out of isolated teachings in the art. *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ 2d 1788, 1792 (Fed. Cir. 1988).

If a modification of a reference destroys the intent, purpose, or function of the invention disclosed in the reference, such a proposed modification is not proper and the

prima facie case of obviousness cannot be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Since the combination of references still does not show each and every claimed element, the claimed invention is not *prima facie* obvious. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Since at least one of the references (Moore, White) teaches away from the claimed invention, this demonstrates a lack of a *prima facie* case of obviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).

MOORE

Moore discloses enabling a user to capture and manage information for later review without interruption of current activity [0011]. Information objects are stored in a database with local origination data [0022]. Objects can be captured manually or automatically [0023, 0024].

Moore does not teach or suggest the following elements of Applicants' claimed invention for the various groups of claims:

Group I and II

"storing in a chronological list. . . when each multimedia object (transient message) is initially rendered at the client (by the browser);" and

“displaying the chronological list with control buttons for enabling a subsequent rendering of the transient messages in . . . succession . . . in response to a user selection of . . . control buttons. . . wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object (transient message)”

Moore appears to be silent on the playing back of (“subsequently rendering”) the stored objects other than discussed in paragraph [0053] and stating generally that the objects are stored for later perusal [0037].

Furthermore, Moore appears to also teach away from the claim element of storing each multimedia object in a chronological list by stating at [0044] that if the object had previously been captured, the existing object record is updated. As such, the new captured object would not be stored chronologically, but would have merely updated a previously stored object. As such, since Moore teaches away from the claimed invention of “storing in a chronological list. . . when each multimedia object (transient message) is initially rendered at the client (by the browser);” Moore is not a proper reference; and as such a *prima facie* case of obviousness has not been demonstrated. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).

Contrary to the examiner’s comments (see Final Office Action page 3, lines 1-3), Applicants could find no teaching in Moore at paragraphs [0011], [0021] or [0022] or elsewhere of enabling a subsequent rendering of the stored multimedia objects *in*

succession in response to a user selection of a control button associated with the list of the stored multimedia objects.

The examiner admits (page 3, lines 9-11 of Final Office Action) that Moore does not explicitly disclose storing the multimedia objects in a chronological list and displaying the multimedia objects in at least one of a forward and backward succession, at a user configurable rate.

WHITE

White discloses displaying images of recently viewed television channels. Multiple recently accessed television channels are stored in a local database. Small screen images corresponding to the channels are displayed on a recent channel display screen. The user uses direction controls on a remote control device to select one of the small screens to make the channel corresponding to the selected screen an active screen. When selected, a live television broadcast signal is displayed in the active screen. [0007] [0008]. White does disclose that the TV recent screen comprises images for television stations that are stored in a chronological database referred to as the "recent channel list". [0054] But what is stored is not what can be played back. White only stores a captured screen image of a broadcast from a TV station. When it is selected, a current live broadcast is displayed, not the content that was stored. As such, White does not enable a subsequent rendering of the *stored* multimedia objects. In addition, what are being stored are not each of the objects as they are initially rendered. White fails to store screen images of each

broadcast if, for example, the station was not being received for more than a certain period of time (see [0065]). In addition, White does not teach or suggest that control buttons are displayed with the list to enable the user to go forward or backward in succession through the chronological list of stored objects.

As such, White does not teach or suggest the following elements of Applicants' claimed invention for the various groups of claims:

Group I and II

“storing in a chronological list. . . *when each multimedia object is initially rendered at the client;*” and

“displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in at least one of a forward and backward succession. . . in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object”

The examiner states that it would have been obvious to store the captured multimedia objects in a chronological list in the system of Moore. However, there is no incentive for Moore to do this since Moore provides that local origination data are stored with the objects. The local origination data may include the time point at which the user selected the object to be captured (see [0022]). With this additional data, Moore would

not have an incentive or motive to have a chronological list for knowing the order sequence the objects were captured.

Since there is no motive for Moore to use a chronological list, then the combination of Moore and White cannot be properly made. If a modification of a reference destroys the intent, purpose, or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness cannot be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Moore also teaches away from the order of objects captured, since Moore overwrites or updates objects that were previously captured [0044]. White also teaches away from the order sequence since some stations are not even captured. That is, White requires that a station be broadcasting for a certain length of time before a screen image is captured and stored (see [0065]). Furthermore, since Moore and White both teach away from a chronological list, this demonstrates a lack of a *prima facie* case of obviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).

HULLINGER

Hullinger discloses a system that captures a local news program broadcast and separates the broadcast into individual news stories, and determines the topic, talent and production characteristics of the stories by comparing the text of the broadcast with statistical information accumulated with other historical data, such as show ratings. The

system provides the combined analysis along with the broadcast itself to a user through a graphical user interface allowing an objective assessment of competitors local new broadcasts. The user at the user interface machine can access and display the data stored in the server (classification, ratings, pacing, average story length, etc.) along with playing the video/audio to see what components of the broadcast affect the ratings for a broadcast (column 4, lines 52-56). Once the stories for one or more broadcasts have been classified and the ratings data for the broadcast has been updated, the user can access the data through the user interface device by playing the broadcasts individually or simultaneously using a specialized video player. The user can also simultaneously or separately display the text of the broadcasts and the ratings data in the form of charts (column 10, lines 57-64). Any time the phrase “stories that make up the data” is used, it means that the application queries the database for a list of stories that fit the specified criteria (column 11, lines 58-60). Same behavior as when the mouse is left-clicked when the cursor is over the chart’s background (column 12, lines 55-56). A single video player is created when the user double clicks on chart data, or selects “video” from a chart’s context menu. The video player is then loaded with the stories that are represented by the chart data object, and the user can watch each of these stories sequentially. Most of the video player’s controls behave like conventional VCR and computer video controls, with the exception being the “track forward” and “track backward” buttons. . . These two buttons allow the user to hop forward (or backward) to the start of the next story (page 12 line 60 to page 13,

line 34). The video player can play stories that are not chronologically contiguous as if there were no gaps between them (see column 13, lines 24-34).

Although Hullinger discloses playing back captured broadcast video segments with playback controls similar to a conventional VCR, what is being played back is what meets certain characteristic or criteria for that broadcast segment as previously determined from certain analysis. There is no playback through a chronological list of multimedia objects as they were initially rendered. The playback is of selected video segments based on certain characteristics associated with that video segment. Likewise, Hullinger does not teach or suggest displaying a chronological list with control buttons. The control buttons of Hullinger are associated with the video player itself, not with the chronological list. As such, Hullinger does not teach or suggest the following elements for each of the group of claims:

“storing in a chronological list. . .when each multimedia object is initially rendered at the client;” and

“displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in at least one of a forward and backward succession. . .in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object ”

The examiner has improperly combined Hullinger with Moore to show displaying multimedia objects in at least one of forward and backward succession in the system of Moore because playing objects in succession frees the burden of the user to select and play the multimedia objects one by one. However, this combination is improperly made because the combination still fails to show a chronological list of multimedia objects as each object was initially rendered, and the combination also fails to show the chronological list with control buttons. Both Moore and Hullinger stores objects in a database with certain characteristics and displays those objects based on the characteristics. Any such playing of objects in succession would be the objects from the database that met certain criteria, and not a succession through a displayed chronological list of multimedia objects as they were initially rendered as claimed in Applicants' claimed invention. Because the combination has failed to show all of the claimed elements, the combination is improper and a *prima facie* case of obviousness has not been met. Since the combination of references still does not show each and every claimed element, the claimed invention is not *prima facie* obvious. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

AHMED

Ahmed discloses a technique whereby an image display can be paused, then resumed at an accelerated rate until a time at which the content of the display corresponds

to the content that would have been displayed had the image been displayed at a normal display rate without the pause, at which time display of the image at the normal display rate resumes. The examiner's characterization of Ahmed (that Ahmed teaches displaying the multimedia objects at a user configurable rate (Office Action page 4, lines 1-3)) is not well formed. Ahmed replays a given image at various rates. Ahmed does not teach or suggest that a subsequent rendering of the stored *different multimedia objects in succession* are displayed at a user configurable rate. Ahmed is merely replaying a given multimedia object at any speed.

The examiner has improperly combined Ahmed with Moore to show displaying multimedia objects at a user configurable rate in the system of Moore because this enables a user to display multimedia objects at his/her speed (Office Action, Page 4, lines 1-6). However, this combination is improperly made because the combination still fails to show a chronological list of multimedia objects as each object was initially rendered, and the combination also fails to show displaying the chronological list with control buttons for enabling a subsequent rendering *of the stored multimedia objects* in succession at a user configurable rate. Any such playing at a user configurable rate would be only of a given multimedia object, and not through a succession of multimedia objects from the list. Because the combination has failed to show all of the claimed elements, the combination is improper and a *prima facie* case of obviousness has not been met. Since the combination of references still does not show each and every claimed element, the claimed

invention is not *prima facie* obvious. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

MOORE, WHITE, HULLINGER, AHMAD

The combination of Moore, White, Hullinger, Ahmad, fails to disclose the following elements of the Group I and II claims:

“storing in a chronological list. . .when each multimedia object is initially rendered at the client;” and

“displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in at least one of a forward and backward succession. . .in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object ”

Since the combination of references still does not show each and every claimed element, the claimed invention is not *prima facie* obvious. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

It appears that the examiner has used Appellant’s disclosure as a blueprint in piecing together the combination of references. Applicant’s disclosure cannot be used as a blueprint to reconstruct the claimed invention out of isolated teachings in the art. *Grain*

Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ 2d 1788, 1792 (Fed. Cir. 1988).

GROUP II CLAIM

The examiner has combined Moore, White, Hullinger, and Ahmed and states in the Office Action at page 4, lines 18-20 that the combination teaches wherein the storing step occurs for a configurable duration of time by relying on Hullinger, Fig. 13, col. 11, lines 25-28. The examiner has erred in the characterization of Hullinger. Hullinger shows discrete data points over a length of time and does not teach or suggest “storing, for a configurable duration of time, in a chronological list, different multimedia objects as each object is initially rendered at the client. As Fig. 13 shows, the data is only for the late news that aired at a certain time. This omits other multimedia objects that would have been rendered chronologically within this same time period. Since Hullinger fails to show this element, either alone or in combination, the combination has been improperly made since the combination does not show all of the elements of the group II claim. As such, a *prima facie* case of obviousness has not been met. Since the combination of references still does not show each and every claimed element, the claimed invention is not *prima facie* obvious. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

In addition, with respect to the Group II claim, White does not store objects for a configurable duration of time. That is, in Applicants' claimed invention, a plurality of different multimedia objects each containing at least one transient message are stored when each multimedia object is initially rendered at the client. The storing of these different multimedia objects will occur for a configurable duration of time. White is silent to this feature. To the contrary, however, White does disclose that each separate TV station has to be broadcasting for a certain time period before a screen image for that TV is stored [0065].

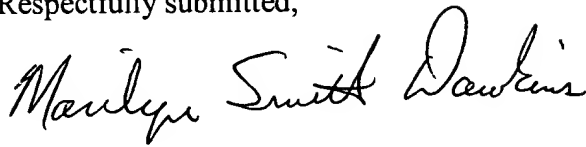
For all of the reasons discussed above with respect to the Group I claims; and since the combination of references still does not show each and every claimed element of the Group II claim including the elements discussed above for the Group I claims and the element unique to the Group II claim "storing for a configurable duration of time," the claimed invention is not *prima facie* obvious. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

CONCLUSION

It is therefore respectfully requested that the Examiner's rejection of Claims 1-4, 7-10, 13-16, and 19-24 under 35 USC 103 be reversed for failing to establish a *prima facie* case of obviousness. It is respectfully submitted that the claims remaining in the

Application are patentable under 35 USC 103 and allowance of these claims to Appellants
is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script that reads "Marilyn Smith Dawkins". The signature is written in black ink and is positioned below the text "Respectfully submitted,".

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APPENDIX

1. A method for displaying, at a client, transient messages received over a network, the method comprising:

storing in a chronological list, independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is initially rendered at the client; and

displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in at least one of a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object.

2. The method of claim 1 wherein each one of the plurality of different multimedia objects is at least one of an animated GIF multimedia object, a moving picture type multimedia object, a vector graphic multimedia object, and a static image multimedia object.

3. The method of claim 1 wherein the step of storing further comprises storing at least one of the multimedia objects at the client.

4. The method of claim 1 wherein the step of storing further comprises storing at least one of the multimedia objects at a server which is in communication over the network with the client.

5. (CANCELED)

6. (CANCELED)

7. The method of claim 1 wherein the storing step occurs for a configurable duration of time.

8. The method of claim 1 wherein the step of storing further comprises storing at a server, which is communicatively connected over the network with the client, each of the multimedia objects in the chronological list as each multimedia object is initially rendered at the client.

9. The method of claim 8 further comprising sending a given one of the different multimedia objects from the chronological list and a corresponding software unit to enable the multimedia object to be played in response to a selection of a replay button sent from the server to be displayed at the client in conjunction with the multimedia object in an area of a document allocated to the multimedia object.

10. A computer program product having computer readable program code means on a computer usable medium having instruction means for enabling a display, at a client, of transient messages received over a network, comprising:

instruction for storing in a chronological list, independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is initially rendered at the client; and

instructions for displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in at least one of a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object.

11. (CANCELED)

12. (CANCELED)

13. The program product of claim 10 wherein the instruction for storing further comprises instructions for storing at a server, which is communicatively connected over the network with the client, each of the multimedia objects in the chronological list as each multimedia object is initially rendered at the client.

14. The program product of claim 10 further comprising instructions for sending a given one of the different multimedia objects from the chronological list and a corresponding software unit to enable the multimedia object to be played in response to a selection of a replay button sent from the server to be displayed at the client in conjunction with the multimedia object in an area of a document allocated to the multimedia object.

15. A computer system having means for displaying, at a client, transient messages received over a network, the system comprising:

means for storing in a chronological list, independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is initially rendered at the client; and

means for displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in at least one of a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object.

16. The computer system of claim 15 wherein each of the different multimedia objects is at least one of an animated GIF multimedia object, a moving picture type multimedia object, a vector graphic multimedia object, and a static image multimedia object.

17. (CANCELED)

18. (CANCELED)

19. The computer system of claim 15 wherein the means for storing further comprises means for storing at a server, which is communicatively connected over the network with the client, each of the multimedia objects in the chronological list as each multimedia object is initially rendered at the client.

20. The computer system of claim 19 further comprising means for sending a given one of the different multimedia objects from the chronological list and a corresponding software unit to enable the multimedia object to be played in response to a selection of a replay button sent from the server to be displayed at the client in conjunction with the multimedia object in an area of a document allocated to the multimedia object.

21. A method for redisplaying, at a client, at least one transient message displayed in a browser, the method comprising:

- identifying a region associated with the at least one transient message;
- clipping the region associated with the at least one transient message;
- storing in a chronological list, independently of a user action, each transient message when each transient message is initially rendered by the browser; and
- displaying the chronological list with control buttons for enabling a subsequent rendering of the transient messages in at least one of a forward and backward succession,

at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given transient message.

22. The method of claim 21 further comprising associating a separate identifier for each stored transient message; and enabling a use of the identifier for the user selection.

23. A computer system having means for redisplaying at least one transient message displayed in a browser, the system comprising:

- means for identifying a region associated with the at least one transient message;
- means for clipping the region associated with the at least one transient message;
- means for storing in a chronological list, independently of a user action, each transient message when each transient message is initially rendered by the browser; and
- means for displaying the chronological list with control buttons for enabling a subsequent rendering of the transient messages in at least one of a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given transient message.

24. A computer program product having computer readable program code means on a computer usable medium having instruction means for enabling a redisplaying of at least one transient message displayed in a browser, the computer program comprising:

- instruction means for enabling an identification of a region associated with the at least one transient message;
- instruction means for enabling a clipping of the region associated with the at least one transient message;

instruction means for storing in a chronological list, independently of a user action, each transient message when each transient message is initially rendered by the browser; and

instruction means for displaying the chronological list with control buttons for enabling a subsequent rendering of the transient messages in at least one of a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given transient message.